

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/808,568	03/25/2004	Vincent de Laforcade	05725.0918-01	4838	
22852 7590 04/06/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP			EXAMINER		
			COMSTOCK, DAVID C		
901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413		ART UNIT	PAPER NUMBER		
,	•		3733		
SUORTENED STATISTICS	AV DERVOR OF DERDOVICE		·		
SHUKTENED STATUTOR	RY PERIOD OF RESPONSE	MAIL DATE	DELIVER	DELIVERY MODE	
31 DAYS 04/06/200		04/06/2007	PAPER		

## Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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	Application No.	Applicant(s) $\dot{v}$				
· <b></b>	10/808,568	DE LAFORCADE, VINCENT				
Office Action Summary	Examiner	Art Unit				
	David Comstock	3733				
The MAILING DATE of this communication app Period for Reply	pears on the cover sheet with	the correspondence address				
A SHORTENED STATUTORY PERIOD FOR REPL' WHICHEVER IS LONGER, FROM THE MAILING D.  Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication.  If NO period for reply is specified above, the maximum statutory period of Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICA 36(a). In no event, however, may a repl will apply and will expire SIX (6) MONTH e, cause the application to become ABAN	ATION. ly be timely filed  HS from the mailing date of this communication. NDONED (35 U.S.C. § 133).				
Status		• .				
1) Responsive to communication(s) filed on 25 M	larch 2004.					
	·					
3) Since this application is in condition for alloware closed in accordance with the practice under E	nce except for formal matter	• •				
Disposition of Claims						
4) ☐ Claim(s) 1-168 is/are pending in the applicatio 4a) Of the above claim(s) is/are withdray 5) ☐ Claim(s) is/are allowed. 6) ☐ Claim(s) is/are rejected. 7) ☐ Claim(s) is/are objected to. 8) ☐ Claim(s) 1-168 are subject to restriction and/or	wn from consideration.					
Application Papers						
9)☐ The specification is objected to by the Examine	er.					
10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.						
Applicant may not request that any objection to the	• ,	` '				
Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the Ex	, , , , , , , , , , , , , , , , , , , ,	•				
Priority under 35 U.S.C. § 119						
12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of:	priority under 35 U.S.C. § 1	19(a)-(d) or (f).				
1. Certified copies of the priority documents have been received.						
2. Certified copies of the priority documents have been received in Application No						
3. Copies of the certified copies of the priority documents have been received in this National Stage						
application from the International Bureau	u (PCT Rule 17.2(a)).					
* See the attached detailed Office action for a list	of the certified copies not re	ceived.				
Attachment(s)						
1) Notice of References Cited (PTO-892)	4) Interview Sun					
2)	_	Mail Date omal Patent Application				
Paper No(s)/Mail Date	6) Other:					

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## **DETAILED ACTION**

## Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-24, 96-134 and 156-168, drawn to a clothing/compact combination, classified in class 132, subclass 293.
- II. Claims 25-95, drawn to a business method, not classifiable in any of the classes or subclasses listed in inventions I, III, or IV.
- III. Claim 135-145, drawn to a method of making a compact, classified in class 264, subclass 239.
- IV. Claims 146-155, drawn to a method of using an interface for choosing a decoration on a container, classifiable in class 345.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product could be used in a process of beautifying oneself rather than a process of doing business.

Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2)

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that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product could be pre-molded into the desired configuration rather than including an additional step of subjecting a blank to pressure to form the desired configuration.

Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the clothing/cosmetic combination and the method of selecting a decoration on a container are not reasonably usable together since the former involves no action by the user and relates only to the matching appearance of the two products while the latter is directed to steps of gathering information and/or performing a business transaction. Furthermore, the mode of operation of the clothing/cosmetic combination comprises wearing or holding while the mode of operation of the latter is performing business steps, which are functionally distinct from the combination apparatus. Further still, the effects are completely different, the former resulting in beauty, the latter resulting in information and/or a business transaction.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the method of doing business and the method of making a compact are not reasonably usable together since the steps of marketing and distributing a product are completely distinct from the steps of forming material into a product.

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Furthermore, the effects are completely different, the former resulting in distribution or increased sales, the latter resulting in a product.

Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the method of doing business and the method of selecting a decoration on a container are not reasonably usable together since the steps of marketing and distributing a product are completely distinct from the steps of gathering information and/or performing a business transaction. Furthermore, the effects are completely different, the former resulting in distribution or increased sales, the latter resulting in information and/or a business transaction.

Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the method of making a compact and the method of selecting a decoration on a container are not reasonably usable together since the steps of forming material into a product are completely distinct from the steps of gathering information and/or performing a business transaction. Furthermore, the effects are completely different, the former resulting in a product, the latter resulting in information and/or a business transaction.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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In addition, this application contains claims directed to the following patentably distinct species of the claimed invention:

- i. Fig. 1
- ii. Fig. 2

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

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showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. Please leave a detailed voice message if examiner is unavailable. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Comstock

EDUARDO (7. HOBERT SUPERVISORY PATENT EXAMINER